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In re Application of: Dvorak, Robert E., et al. : PETITION TO WITHDRAW
Application No. 09/755,355 : RESTRICTION REQUIREMENT
Filed: January 05, 2001 : UNDER 37 C.F.R. 1.144
Attorney Docket No.: BFLR 1002-1 :
For: METHOD AND SYSTEM FOR :
SUPPLYING SYNTHETIC SALES :
HISTORIES :
:

This is in response to applicant's petition filed on June 08, 2006, which is being treated under 37 C.F.R. 1.144 to have the October 24, 2005 Restriction requirement withdrawn. The delay in treating this petition is sincerely regretted.

The petition is **DENIED**.

Petitioner has presented arguments directed to errors made by the examiner in justifying a distinction between the two groups of invention. The Office action dated October 24, 2005 indicated that the distinction between Groups I and II was that Group I was directed towards supplying sales history to a good and Group II was directed towards supplying sales history to a selling location. The petitioner argues that there is significant overlap between independent claims 1 and 16 and that the Examiner relied on an outdated version of the MPEP in the restriction requirement, as the MPEP restriction criteria was revised in August, 2005. Therefore, petitioner asserts that Examiner merely stated that the inventions were separately usable and did not show that the subcombinations do not overlap in scope and are not obvious variants.

A review of the file record indicates the rationale used in the October 24, 2005 Office action to distinguish between the Group I and II inventions. Specifically, Examiner asserted that Group I and Group II are separately usable and asserted that Group I had the separate utility of supplying sales history to a good lacking sales history, such as a new product being introduced to market, whereas Group II had a separate utility such as opening a new store and supplying sales data to this new store. Therefore, Examiner sufficiently established that the Groups are separately usable. This further supports that there is no overlap in scope and that the Groups are not obvious variants.

since the Groups have separate uses and thus Group I can be infringed without also infringing Group II. The assertion of distinctness is further supported by the argument made by Petitioner on May 26, 2005, where applicant states "As compared to claim 1, the focus of claim 16 is cloning data from one selling location to an other selling location, for instance, when opening a new store or expanding an old one", which is cited by the Examiner in the Restriction Requirement. This distinction is further supported on pages 1 and 3-4 of the originally presented specification. Finally, examiner has stated that the Groups require different searches.

As to the Examiner relying on an outdated version of the MPEP, the revisions made to the MPEP in 2005 have been reviewed. The third revision to the MPEP in August 2005 did revise chapter 800. However, the fourth revision to the MPEP in October 2005 did not make any changes to chapter 800. The examiner relied on the most recent version of the MPEP. At that time, MPEP 806.05(d) did include that the subcombinations were considered distinct if they do not overlap in scope and are not obvious variants. Looking at the arguments made by the Petitioner, Petitioner does not provide any specific evidence or examples to show how the Groups do overlap in scope or are obvious variants of each other. Further, in reviewing the record as a whole, Petitioner has asserted in the May 26, 2005 remarks that claim 16 of Group II is distinct from claim 1 of Group I. Accordingly the restriction between Groups I and II is considered proper.

Petitioner further argues that there is not a serious burden, as the examiner previously searched all the claims before restriction and that class 705, subclass 10, is identified as applicable to all the claims in both groups.

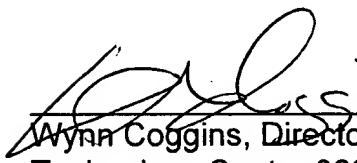
A review of the file record indicates that the Examiner did present a rejection of all the claims in an office action dated December 10, 2004. The record further indicates that the Petitioner filed arguments on May 26, 2005, which caused the issuance of the second non-final office action containing the restriction requirement on October 24, 2005. The Examiner references these arguments, specifically page 20, in the restriction requirement. On page 20 of the arguments, Applicant states "As compared to claim 1, the focus of claim 16 is cloning data from one selling location to an other selling location, for instance, when opening a new store or expanding an old one". Therefore, the record shows that Examiner found this argument, which cites the distinction between claims 1 and 16, to be persuasive, causing the Examiner to remove the previous grounds of rejection and raise the restriction requirement. Since 37 CFR 1.142 states that a requirement for restriction may be made at any time before final action, this timing of the restriction requirement is appropriate. Thus, the persuasive argument by the Petitioner convinced the Examiner that the claim limitations had been misinterpreted in the art rejection, and identified for the Examiner that there was distinctness and burden between the two Groups.

As for there not being serious burden since class 705, subclass 10, is identified as applicable to all the claims in both Groups, petitioner is directed to MPEP § 808.02, which states that the examiner must establish burden and can do so by showing **one of** (A) Separate classification thereof, (B) A separate status in the art when they are

classifiable together, or (C) A different field of search. In this case, the examiner stated that the search required for Group I is not required for Group II because the inventions are distinct, as established previously in the restriction requirement, and thus restriction for examination purposes is proper. Therefore, examiner has shown burden by establishing (C), since Examiner is asserting that it is necessary to search for one of the inventions in a manner that is not likely to result in finding art pertinent to the other inventions. Further, form paragraph 08.21.03 used by the Examiner was the current form paragraph for showing this type of burden at the time the restriction requirement was made. Therefore, the Groups being identified in different classes and/or subclasses is not required to establish burden, as argued by Petitioner. Accordingly, the petition to withdraw Restriction Requirement under 37 CFR 1.144 is **DENIED**.

Given the decision mailed October 24, 2007 which granted the petition to revive filed June 26, 2007, this application has been returned to pending status. The application is being forwarded to the examiner of record to consider and treat the amendment filed June 26, 2007.

Inquiries related to this decision may be directed to Supervisory Patent Examiner Tariq R. Hafiz at (571) 272-6729.



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Th/snm: 10/30/07

